

REMARKS

Claims 1-46 are pending in this application. A two way restriction is required in the Office Action mailed January 21, 2005 between Group I (Claims 1-14 and 33-46) and Group II (Claims 15-32). Applicants affirm election without traverse of the invention of Group II as discussed in a telephone conference with the Examiner on January 5, 2005. Claims 1-14 and claims 33-46 have been withdrawn pending rejoinder should subsequent linking claims be allowed. Claim 16 and claim 32 have been amended. These amendments find support in the specification and the previous claims. Specifically, claim 16 has been amended to remove the term "glass-like", so that it is now consistent with claim 15. Claim 16 has also been amended to recite "processing" instead of "grinding," to render it consistent with claim 15. Claim 32 has been amended to recite, specifically, other substances for treating compositions, and finds support in the specification in paragraph [0041]. Thus, it is submitted that no new matter has been added as a result of the amendments to the claims. Applicants respectfully traverse the rejections for the reasons expressed herein below.

A. Rejection of claims 16, 19, 21, 23, 25, 27, and 32 under 35 U.S.C. § 112, second paragraph

Claims 16, 19, 21, 23, 25, 27, and 32 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

With regard to claims 16, 19, 21, 23, 25, and 27, Applicants maintain that the term "glass-like" does not render the claims indefinite; however, for consistency with the

other claims and to more quickly advance this application to a condition of allowance, Applicants have deleted the word "glass-like." It is submitted that this amendment has been made to correct matters of form only, and should not be construed as affecting the scope or equivalency of the claims.

Claim 32 has been amended to specifically recite as a Markush group other products for treating substances, thus rendering the claim definite. It is further submitted that this amendment has been made to correct matters of form only, and should not be construed as affecting the scope or equivalency of the claims.

Accordingly, withdrawal of the rejections of claims 16, 19, 21, 23, 25, 27, and 32 under 35 U.S.C. § 112, second paragraph, is respectfully requested.

B. Rejection of claims 15-32 under 35 U.S.C. § 103(a)

The Examiner has rejected claims 15-32 under 35 U.S.C. § 103(a) as being obvious in light of United States Patent No. 6,159,257 to Koutlakis *et al.* (hereinafter, the '257 patent). Specifically, the Examiner asserts that the '257 patent discloses polysaccharide particles that are made by the same process within the same size ranges, which thereby renders obvious the claims of the present invention. The Examiner acknowledges that the '257 patent does not teach the claimed size range for the polysaccharide particles, but asserts that because the reference does not recite a size limitation, all sizes are rendered obvious.

As an initial matter of clarification, it is noted that the step of crushing or grinding is not necessary to practice the invention. The fragments in certain embodiments can

be manufactured by cutting the extrudate as it exits the die. See, for example, Example 12, paragraphs 110-112.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the combination of prior art. MPEP §2143 and §2143.03. In addition, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP §2143. Put another way, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination or modification. Applicants respectfully submit that the '257 patent does not render obvious claims 15-32 of the present invention because the '257 patent does not recite or suggest the claimed size limitations.

Under §103, the burden is on the USPTO to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art and/or that knowledge generally available to one of the ordinary skill in the art would lead that individual to combine the relevant teachings. In this instance, the Examiner acknowledges that the '257 patent only explicitly discloses a particle size range of about 12 mesh. Applicants assert that even if the claims of the cited reference are not construed to be limited to the preferred embodiments, the reference still fails to implicitly or explicitly teach the claimed size range in the instant application, which is a particle size of about 6mm to about 100mm. The lack of a limitation within this reference cannot be inferred to disclose or even reasonably suggest the limitation of size to about 6mm to about 100mm. Otherwise, any reference (analogous or not)

could be said to render the claims of the invention obvious when it fails to disclose the very limitation that distinguishes the invention. Clearly, this type of argument is inappropriate. Thus, it is respectfully submitted that the USPTO has not met its *prima facie* burden, and the Examiner's use of the '257 patent is erroneous. Thus, it is submitted that the instant claims are not obvious in light of the '257 patent, and the rejection should be withdrawn.

Even if the *prima facie* burden were to be met, it is rebutted by the fact that the size range disclosed in the instant application is shown to be particularly useful in grinding, polishing, and drying compositions that use mechanical agitation. See, for example, Examples 18, 20, 24, 26, and 28 listed in the specification. The advantages of the invention are derived, at least in part, by the claimed particle size. Thus, the parameters and the advantages arising such a particle size are not obvious, since these sizes are not disclosed or suggested in the '257 patent. Applicants respectfully request that the rejection be withdrawn.

For at least the reasons discussed above, Applicants respectfully request reconsideration of the rejection of claims 15-32 for obviousness over the '257 patent. Applicants believe that claims 15-32 define over the prior art of record and are in proper form for allowance. Applicants respectfully request allowance of claims 15-32.

C. Rejection of claims 15, 17, 18, 20, 22, 24, 26, and 28-32 under 35 U.S.C. § 103(a)

The Examiner has rejected claims 15, 17, 18, 20, 22, 24, 26, and 28-32 under 35 U.S.C. § 103(a) for obviousness over United States Patent No. 5,367,068 to Lane *et al.*

(hereinafter, the '068 patent). Specifically, the Examiner asserts that the '068 patent discloses polysaccharide particles that are made by the same process within the same size ranges, which thereby renders obvious the claims of the present invention. The Examiner acknowledges that the '068 patent does not teach the claimed size range for the polysaccharide particles, but asserts that because the reference does not recite a size limitation, all sizes are rendered obvious.

As an initial matter, as was discussed above, it is noted that the step of crushing or grinding is not necessary to practice the invention. The fragments in certain embodiments can be manufactured by cutting the extrudate as it exits the die. See, for example, Example 12, paragraphs [110-112].

With that fact noted, Applicants again submit that the claims as presented are not obvious in light of the '068 patent. First, for reasons similar to those discussed above, The USPTO has failed to meet its *prima facie* burden because the '068 patent fails to disclose the claimed size range, and further fails to teach implicitly or explicitly such a size range. Examiner acknowledges that the '068 patent only explicitly discloses a particle size range of about 12 mesh. The lack of a limitation to size cannot be inferred to disclose or even reasonably suggest the size range claimed in the instant application (from about 6mm to about 100mm). Otherwise, any reference (analogous or not) could be said to render the claims of the invention obvious when it fails to disclose the very limitation that distinguishes the invention. Clearly, this type of argument is inappropriate. Thus, it is respectfully submitted that the USPTO has not met its *prima facie* burden, and the Examiner's use of the '068 patent is erroneous. Thus, it is

submitted that, as with the '257 reference, the instant claims are not obvious in light of the '068 patent, and the rejection should be withdrawn.

Even if the *prima facie* burden were to be met, it is rebutted by the fact that the size range disclosed in the instant application is shown to be particularly useful in grinding, polishing, and drying compositions that use mechanical agitation. See, for example, Examples 18, 20, 24, 26, and 28 listed in the specification. The advantages of the invention are derived, at least in part, by the claimed particle size. Thus, the parameters and the advantages arising such a particle size are not obvious, since these sizes are not disclosed or suggested in the '068 patent. Applicants respectfully request that the rejection be withdrawn.

Further, it is noted that the Office Action mailed January 21, 2004 cites case law for the general proposition that a reference is not limited to the preferred embodiment but rather to what the reference reasonably teaches. The Applicants agree with the propositions set forth by the courts; however, the Applicants assert that the cited references (the '257 and '068 patents) do not teach the disclosed size ranges, and further, the Examiner has not indicated how such a specific size range could reasonably be inferred from these cited references. To the extent that the claims of the cited references fail to recite a size range, it is submitted that the case law propositions regarding overlapping ranges are inapplicable. In these cases, the courts construed claims where ranges were affirmatively disclosed. However, the cited references do not affirmatively disclosure a range, thus no overlap occurs. Thus, the Applicants respectfully request the obviousness rejections in light of both references be withdrawn.

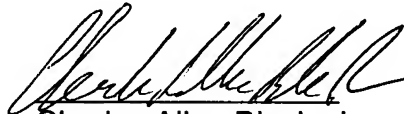
CONCLUSION

Applicants submit that claims 15-32 of the present invention are a non-obvious method for producing polysaccharide fragments and related products. The cited references do not teach or suggest the claimed product or process having the claimed size ranges. In view of the foregoing, Applicants respectfully submit that the subject application is in condition for allowance. Accordingly, reconsideration of the rejections and allowance of claims 15-32 at an early date are earnestly solicited.

If the undersigned can be of assistance to the Examiner in addressing issues to advance the application to allowance, please contact the undersigned at the number set forth below.

Respectfully submitted,

4/21/09
Date


Charles Allen Black, Jr.
Registration No. 53,835
Customer No. 41,835

KIRKPATRICK & LOCKHART NICHOLSON GRAHAM LLP
Henry W. Oliver Building
535 Smithfield Street
Pittsburgh, Pennsylvania 15222
Telephone: (412) 355-6319
Facsimile: (412) 355-6501